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PATENT CASE: IN01481KB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
A. Palani *et al.*	Examiner: Cecilia C. Chang
Serial No.: **10/629,466**	Group Art Unit: 1625
Filed: **07/29/2003**	Date: August 18, 2005
For: **"PIPERIDINE DERIVATIVES USEFUL AS CCR5 ANTAGONISTS**	

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Sir:

This communication is in response to the Office Action issued on June 17, 2005 in the subject case. This communication is being faxed to the Examiner's attention at 703-872-9306. A petition for a two-month extension of time is enclosed herewith.

Claims 21-40 are originally pending in the case. The Examiner restricted the claims into eight groups:

Group I: Claims 21-30, drawn to compounds of formula (I) and pharamaceutical compositions comprising the compounds of formula (I), wherein both R^1 and R^2 are nonheterocyclic, and R^3 is substituted or unsubstituted pyrimidine;

Group II: Claim 21-30, drawn to compound of formula (I) and pharamaceutical compositions comprising the compounds of formula (I), wherein one of R^1 or R^2 is heterocyclic, and R^3 is substituted or unsubstituted pyrimidine;

Group III: Claims 21-30 drawn to compounds of formula (I) and pharamaceutical compositions comprising the compounds of formula (I),

wherein R^1 and R^2 are pyridinyl or phenyl optionally substituted, and R^3 is substituted or unsubstituted pyridine;

Group IV: Claims 21-30, drawn to compounds of formula (I) and pharamaceutical compositions comprising the compounds of formula (I), wherein R^3 is substituted or unsubstituted heteroaryl not encompassed by groups I-III;

Group V: Claims 31-33, drawn to methods of treating human immunodeficiency virus employing the compounds of formula (I) and the pharmaceutical compositions comprising the compounds of formula (I);

Group VI: Claims 34-36, drawn to methods of treating human immunodeficiency virus employing the compounds of formula (I) and additional one or more antiviral or other agents ;

Group VII: Claim 38-39, drawn to a method of treating solid organ transplant rejection, graft v. host disease, arthritis, etc., using single or multiple active ingredients;

Group VIII: Claim 40, drawn to a pharmaceutical "kit", i.e., medicinal packaging.

The Examiner additionally required: a) if electing from among Groups I-IV, the election of a single disclosed species for prosecution on the merits; b) if electing from group V, the election of a single disclosed active compound for the method; c) if electing from group VI, the election of a single disclosed "combination" of one active compound with every active ingredient in the combination named, for the method; and d) if electing from group VII, the election of a single disclosed disorder together with a single active ingredient alone or a single disclosed "combination" of one active compound with every active ingredient in the combination named, for the method.

Applicants are puzzled by the restriction into these numerous Groups. Applicants believe that all claims 21-40 form part of one and the same invention. Applicants further believe that when there is a linking claim encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of claims 21-40 as filed would not cause undue burden. Applicants further believe that the same art search will most probably apply to

the alleged separate inventions, and respectfully submit that the restriction is improper.

Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "independent" if " there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above eight groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

Furthermore, in order to comply with the Examiner's requirement, Applicant is electing, with traverse, the invention cited as Invention Group No. I by the Examiner. Additionally, in order to comply with the requirement that a species be elected for examination purposes, Applicant is electing compound 8 on page 50 of the specification.

On page 5 of the Office Action, the Examiner has indicated that the compounds of Group I have been elected prosecuted in the parent application, and that the Applicant, in order for the reply to the present restrict requirement to be complete, must include an election of the remaining invention to be examined even though the requirement be traversed.

In response, Applicant is separately filing a declaration of express abandonment per 37 C.F.R. §1.138 for the parent case to preclude any overlap between the present case and the parent. A copy of this declaration is enclosed herewith.

If the Examiner has questions, the Examiner is invited to contact the undersigned.

August 18, 2005
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Respectfully submitted,

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